

Partner

**Amanda L. O'Donnell**

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📍 Chicago, IL



## Profile

"I enjoy the entire patent process, from working with inventors to help them describe and capture their ideas, to advising businesses on maximizing the value of their IP assets."

Amanda Lowerre O'Donnell focuses her intellectual property law practice primarily on patent prosecution, patent licensing, and commercial clearance assessments, with additional experience with litigation and licensing negotiations. Within the realm of patent prosecution and licensing, she has primarily focused on mechanical technologies, business methods, and software. A skilled counselor on the leveraging of intellectual property assets, Amanda excels at helping clients maximize the value of their IP budgets by developing global filing and prosecution strategies that fit with each company's customized needs and goals.

Amanda has worked with clients in the U.S. and abroad in a variety of technical fields and product applications, including electronic components, food processing, packaging technology, and medical devices. She has focused experience in energy and renewable energy applications, including with carbon sequestration, photobioreactors, and distillation columns. Amanda has counseled numerous clients on business method protections, including clients engaged in diverse technology applications such as insurance software and computer systems, Internet advertising and promotional methods, and social network applications. Amanda also has considerable experience advising clients regarding open-source software issues including licensing, conflict analysis, and risk management.

Amanda is a member of Fitch Even's Executive Committee and Chair of the Marketing and Client Development Committee.

### Education

J.D., University of Wisconsin, 2005, *cum laude*

B.S., Mechanical Engineering, Saint Louis University, 2002, *cum laude*

### Bar Admissions

Illinois

U.S. Patent and Trademark Office

U.S. District Court for the Northern District of Illinois

### Recognition

Named a Leading Lawyer in Illinois in Intellectual Property Law and Patent Law (2022–24)

Selected as an Emerging Lawyer in Illinois in Intellectual Property Law and Patent Law (2015–20)

Judicial Intern for Dane County Circuit Judge Moria Krueger

*Wisconsin Women's Law Journal*, Articles Editor

Bruce F. Beilfuss Memorial Award for Outstanding Service to University of Wisconsin Law School

## Representative Matters

- Drafts and negotiates numerous licensing, development, and business agreements on behalf of clients of all sizes.
- Provides strategic IP counseling, including procuring trademark and patent rights, for startup companies.
- Advises a global consumer products company on numerous patent matters, developing strategies to protect proprietary ideas, and successfully prosecuting patents in key technologies.
- Successfully drafts and prosecutes utility patents for a leading global food and beverage company and for a multinational manufacturer of access control products.
- Conducts open source clearance reviews.  
Counseled multiple marketing and promotion agencies by conducting commercial clearance reviews and negotiating critical patent licenses.

## Presentations + Publications

### Presentations

- “Navigating Open Source Risk with Tools for Usage Evaluation and License Compliance,” Fitch Even Webinar, with Joseph F. Marinelli and Steven G. Parmelee, February 28, 2019.
- Advanced Patent Prosecution Workshop 2018: Claim Drafting & Amendment Writing, Practising Law Institute, Chicago, September 27–28, 2018.
- “Going Paperless: No Time Like the Present,” Chicago Bar Association, Chicago, September 12, 2018.
- Advanced Patent Prosecution Workshop 2017: Claim Drafting & Amendment Writing, Practising Law Institute, Chicago, September 12–13, 2017.
- Advanced Patent Prosecution Workshop 2016: Claim Drafting & Amendment Writing, Practising Law Institute, Chicago, September 14–15, 2016.
- Advanced Patent Prosecution Workshop 2015: Claim Drafting & Amendment Writing, Practising Law Institute, Chicago, September 10–11, 2015.
- Advanced Patent Prosecution Workshop 2014: Claim Drafting & Amendment Writing, Practising Law Institute, Chicago, September 11-12,

### Services

Advertising, Marketing + Promotions  
International IP Protection  
IP Portfolio Management  
IP Strategy Development  
IP Transactions  
Patent Preparation + Prosecution  
Product Clearance + Legal Opinions

### Industries

Artificial Intelligence  
Computer Software + Hardware  
Consumer Products + Packaging  
Electronics  
Energy + Clean Technology  
Food + Agricultural Sciences  
Internet + E-Commerce  
Material Science  
Mechanical Engineering + Manufacturing  
Medical Devices + Diagnostics  
Transportation

2014.

- “*Ex Parte* Prosecution?—Third-Party Pre-Issuance Submissions,” Los Angeles Intellectual Property Law Association’s 2013 Washington in the West Conference, Los Angeles, January 29, 2013.
- “Third-Party Pre-Grant Prior Art Submissions Under the America Invents Act,” Fitch Even Webinar, August 23, 2012.
- “Living in a Post-Bilski World; Has the Patent Office Succeeded in Taking the Abstract Out of ‘Abstract?’”, Fitch Even Webinar, August 25, 2010.

## Publications

- Lowerre O’Donnell, A. and Thompson, J., “Toy Meets World: IP Strategies for the Toy Industry,” *Licensing Journal*, vol. 41, no. 5, May 2021: 19–26.
- Lowerre O’Donnell, A. and Thompson, J., “Toy Meets World: IP Strategies for the Toy Industry,” *Landslide*, American Bar Association, vol. 13, no. 3, January/February 2021.

## Memberships

- Chicago Women in IP
- Intellectual Property Law Association of Chicago
  - Outreach Committee, 2010–11